

## U.S. Patent and Trademark Office, Commerce

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AUTHORITY: 15 U.S.C. 1123; 35 U.S.C. 2(b)(2).

SOURCE: 57 FR 29642, July 6, 1992, unless otherwise noted.

EDITORIAL NOTE: Nomenclature changes to part 3 appear at 68 FR 14337, Mar. 25, 2003.

### §3.1 Definitions.

For purposes of this part, the following definitions shall apply:

*Application* means a national application for patent, an international patent application that designates the United States of America, or an application to register a trademark under section 1 or 44 of the Trademark Act, 15 U.S.C. 1051 or 15 U.S.C. 1126, unless otherwise indicated.

*Assignment* means a transfer by a party of all or part of its right, title

and interest in a patent, patent application, registered mark or a mark for which an application to register has been filed.

*Document* means a document which a party requests to be recorded in the Office pursuant to §3.11 and which affects some interest in an application, patent, or registration.

*Office* means the United States Patent and Trademark Office.

*Recorded document* means a document which has been recorded in the Office pursuant to §3.11.

*Registration* means a trademark registration issued by the Office.

[69 FR 29878, May 26, 2004]

### DOCUMENTS ELIGIBLE FOR RECORDING

#### §3.11 Documents which will be recorded.

(a) Assignments of applications, patents, and registrations, accompanied by completed cover sheets as specified in §§3.28 and 3.31, will be recorded in the Office. Other documents, accompanied by completed cover sheets as specified in §§3.28 and 3.31, affecting title to applications, patents, or registrations, will be recorded as provided in this part or at the discretion of the Director.

(b) Executive Order 9424 of February 18, 1944 (9 FR 1959, 3 CFR 1943-1948 Comp., p. 303) requires the several departments and other executive agencies of the Government, including Government-owned or Government-controlled corporations, to forward promptly to the Director for recording all licenses, assignments, or other interests of the Government in or under patents or patent applications. Assignments and other documents affecting title to patents or patent applications and documents not affecting title to patents or patent applications required by Executive Order 9424 to be filed will be recorded as provided in this part.

(c) A joint research agreement or an excerpt of a joint research agreement will also be recorded as provided in this part. A joint research agreement or excerpt of a joint research agreement submitted for recording by the Office must include the name of each party to the joint research agreement, the date

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the joint research agreement was executed, and a concise statement of the field of invention.

[62 FR 53202, Oct. 10, 1997, as amended at 70 FR 1824, Jan. 11, 2005]

### § 3.16 Assignability of trademarks prior to filing of an allegation of use.

Before an allegation of use under either 15 U.S.C. 1051(c) or 15 U.S.C. 1051(d) is filed, an applicant may only assign an application to register a mark under 15 U.S.C. 1051(b) to a successor to the applicant's business, or portion of the business to which the mark pertains, if that business is ongoing and existing.

[64 FR 48926, Sept. 8, 1999]

#### REQUIREMENTS FOR RECORDING

### § 3.21 Identification of patents and patent applications.

An assignment relating to a patent must identify the patent by the patent number. An assignment relating to a national patent application must identify the national patent application by the application number (consisting of the series code and the serial number, e.g., 07/123,456). An assignment relating to an international patent application which designates the United States of America must identify the international application by the international application number (e.g., PCT/US90/01234). If an assignment of a patent application filed under § 1.53(b) is executed concurrently with, or subsequent to, the execution of the patent application, but before the patent application is filed, it must identify the patent application by the name of each inventor and the title of the invention so that there can be no mistake as to the patent application intended. If an assignment of a provisional application under § 1.53(c) is executed before the provisional application is filed, it must identify the provisional application by the name of each inventor and the title of the invention so that there can be no mistake as to the provisional application intended.

[69 FR 29878, May 26, 2004]

### 37 CFR Ch. I (7–1–05 Edition)

### § 3.24 Requirements for documents and cover sheets relating to patents and patent applications.

(a) *For electronic submissions:* Either a copy of the original document or an extract of the original document may be submitted for recording. All documents must be submitted as digitized images in Tagged Image File Format (TIFF) or another form as prescribed by the Director. When printed to a paper size of either 21.6 by 27.9 cm (8½ by 11 inches) or 21.0 by 29.7 cm (DIN size A4), the document must be legible and a 2.5 cm (one-inch) margin must be present on all sides.

(b) *For paper or facsimile submissions:* Either a copy of the original document or an extract of the original document must be submitted for recording. Only one side of each page may be used. The paper size must be either 21.6 by 27.9 cm (8½ by 11 inches) or 21.0 by 29.7 cm (DIN size A4), and in either case, a 2.5 cm (one-inch) margin must be present on all sides. For paper submissions, the paper used should be flexible, strong white, non-shiny, and durable. The Office will not return recorded documents, so original documents must not be submitted for recording.

[69 FR 29879, May 26, 2004]

### § 3.25 Recording requirements for trademark applications and registrations.

(a) *Documents affecting title.* To record documents affecting title to a trademark application or registration, a legible cover sheet (see § 3.31) and one of the following must be submitted:

- (1) A copy of the original document;
- (2) A copy of an extract from the document evidencing the effect on title; or
- (3) A statement signed by both the party conveying the interest and the party receiving the interest explaining how the conveyance affects title.

(b) *Name changes.* Only a legible cover sheet is required (See § 3.31).

(c) *All documents.* (1) *For electronic submissions:* All documents must be submitted as digitized images in Tagged Image File Format (TIFF) or another form as prescribed by the Director. When printed to a paper size of either 21.6 by 27.9 cm (8½ by 11 inches) or 21.0 by 29.7 cm (DIN size A4), a 2.5 cm